REMARKS

Claims 1-4, 6-23, 25-39 are pending in the application, with claims 1, 20, and 39 being independent. Reconsideration of Applicant's claims is respectfully requested in light of the following remarks.

Claims 1-4, 6-23, 25-39 are rejected under 35 USC. §103(a) over U.S. Patent No. 7,133,898 (Malik) in view of U.S. Patent No. 6,708,205 (Sheldon). Applicant respectfully requests that the rejections of claims 7-10, and 26-29 be withdrawn because Malik and Sheldon, either alone or in combination, fail to describe or suggest any of the limitations of these dependent claims. For instance, neither Malik nor Sheldon describe or suggest determining that an entity is associated with the user based, at least in part, on positive user actions that include "replying to, forwarding, saving or printing an e-mail received from the entity," as recited in claim 7; "moving an e-mail from a first folder to a second folder," as recited in claim 8; or "leaving an e-mail from the entity open for a predetermined period of time," as recited in claim 10. Likewise, neither Malik nor Sheldon describe or suggest the similar limitations in claims 26-29.

With respect to claim 1, the Office Action noted that Malik does not describe determining an entity is associated with the user based on positive user actions and adding the entity to the list when the entity is determined to be associated with the user based on positive user actions. Instead, the Office Action relies on Sheldon for this feature. However, even assuming for the sake of argument that Sheldon describes determining an entity is associated with a user based on positive user actions as well as the corresponding adding limitation, Sheldon does not describe or suggest the specific actions recited in dependant claims 7-10, and similarly in dependent claims 26-29.

In Sheldon, the user creates an accepted list, and an unaccepted list of email addresses. If an incoming e-mail's source is on the accepted list, the email is stored. On the other hand, if an incoming e-mail's source is on the unaccepted list, the email is deleted. To create such lists, and thus define future system behavior, a user is required to evaluate each of several impacted email sources and to explicitly associate such email sources with either of the accepted list or the

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unaccepted list. ("[A] user can review e-mails received from new sources, and decide whether to place these sources on the list of accepted or unaccepted e-mail addresses." *Col. 5:54-56.*) For instance, a series of user actions are required to place the email source on the accepted list, which includes selecting the particular e-mail from a list of emails, accessing a "change access" drop down box, and selecting "Accept Sender" option in the dropdown box. *Col. 11: 32 -36.*

Thus, none of Sheldon's teachings disclose the use of positive user actions with respect to messages. And, with greater particularity, none of Sheldon's actions involve "replying to, forwarding, saving or printing an e-mail received from the entity," as recited in claim 7; "moving an e-mail from a first folder to a second folder," as recited in claim 8; or "leaving an e-mail from the entity open for a predetermined period of time," as recited in claim 10.

While these deficiencies of Sheldon are acknowledged by the Office Action (Office Action, page 3), the Office Action relies on Malik for the specific actions recited in dependent claims 7-10. Office Action, pages 5-6.

Initially, Applicant requests clarification of the rejection being asserted due to an apparent logical inconsistency, which renders the Applicant unable to appreciate (or, more formally, to receive notice of) the actual rejection being applied. Specifically, in the first instance, the Office Action indicates that Malik does not describe or suggest determining that an entity associated with the user based on positive user actions, but then asserts that Malik does describe this feature with respect to the specific actions recited in dependent claims 7-10. If Malik does not describe or suggest determining that an entity associated with the user based on general positive user actions, then Malik can not describe or suggest doing so based on the specifically recited actions. Therefore, the rejection leaves the Applicant unsure whether the Office is asserting that Malik discloses all features of the claims, or only a portion of them and, accordingly is improper.

In either event, neither Malik nor Sheldon describe determining that an entity is associated with the user based on the specific actions recited in dependent claims 7-10. As noted above, none of the actions described by Sheldon are "replying to, forwarding, saving or printing an e-mail received from the entity," as recited in claim 7; or "moving an e-mail from a first folder to a second folder," as recited in claim 8; or "leaving an e-mail from the entity open for a predetermined period of time," as recited in claim 10.

In rejecting claim 7, the Office Action cites to Col. 1, lines 30-32 and Col. 2, line 2 in Malik. However, these cited portions merely describe that a user can review and reply to e-mail. These portions do not describe or suggest that such actions are the basis for determining that an entity is associated with a user, much less adding the entity to the maintained list when the entity is determined to be associated with the user based on positive user actions that include replying to, forwarding, saving, or printing an e-mail received from the entity, as recited in claim 7.

In rejecting claims 8 and 10, the Office Action cites Fig. 8, Ref #810 & 812 of Malik. However, the referenced figure merely displays two sections of emails received from "Contacts" and "Registered Vendors" respectively. This figure does not even depict an e-mail being open, but rather depicts "a user interface for displaying sorted e-mail." *Col. 7: 53-54*. As such, the cited portions do not describe or suggest leaving an e-mail open for a predetermined time, much less determining that an entity is associated with a user based on such an action or adding the entity to the maintained list when the entity is determined to be associated with the user based on such an action, as recited in claim 10.

Therefore, Applicant submits that independent claims 7, 8, 10 and claim 9 that depend from claim 8 are allowable over Malik in view of Sheldon for at least the reasons above. Similarly, Claims 26-29 recite features similar to those in claims 7-10 and should be allowable for the same reasons.

Additionally, Applicant submits that the final status of the current Office Action is not proper. The reference U.S. Patent No. 6,708,205 (Sheldon) is new and was not cited in the non-final action. Applicant's prior response to the non-final action simply incorporated the subject matter of then-pending dependant claim 5 into claim 1. Therefore, the new rejection of the combined subject matter of claim 1 and claim 5 was not necessitated Applicant's claim amendment and renders the final status of current Office Action improper. Applicant requests that the finality of this rejection be removed and, to the extent any rejections are maintained, that a new Office Action be sent in lieu of an advisory action.

Further, Applicant made no claim amendments in this response. Should there be any new rejections in the next Office Action, Applicant respectfully requests that the next Office action be non-final.

Conclusion

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, objection, issue, or comment, including the Office Action's characterizations of the art, does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment or cancellation of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment or cancellation. Applicant reserves the right to prosecute the rejected claims in further prosecution of this or related applications.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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